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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,621	03/30/2004	JonYeon Oh	2003 P 17843 US 01	3473
7590 08/31/2005			EXAMINER	
Elsa Keller, Legal Assistant Intellectual Property Department SIEMENS CORPORATION 170 Wood Avenue South Iselin, NJ 08830			NGUYEN, TRAN N	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,621

Applicant(s)

OH ET AL.

Examiner

Tran N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-15,21 and 22 is/are rejected.
- 7) ☒ Claim(s) 6,7 and 16-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-5, 8, and 10-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gerrand et al (US 5,864,188)** in view of **Kawakami et al (US 6,727,613)**.

Gerrand discloses a coverplate and gearhousing (figs 1-7) for an electric motor including: a coverplate (1), and a gearhousing (4), wherein one of the gearhousing and coverplate includes loop structure (150) and the other of the gearhousing and coverplate includes guides (152) such that the loop structure engages with the guides in a snap-fit arrangement to secure the coverplate with respect to the gearhousing, when the loop structure and guides are in the snap-fit arrangement so as to prevent rotation of the coverplate with respect to the gearhousing about an axis, wherein the coverplate (1) comprises the loop structure (150) while the guides (152) are provided on the gearhousing; the loop structure includes at least a pair of enclosed loops disposed in spaced relation on the coverplate and the gearhousing includes a pair of guides each guide defines a pocket and a locking tab extends into each pocket, with a locking tab being engaged with an associated enclosed loop when the coverplate and gearhousing are in the snap-fit arrangement (figs 1-3).

Gerrand substantially discloses the claimed invention, except for the limitations of the following:

(a) and wherein one of the gearhousing and coverplate includes locators extending therefrom and the other of the gearhousing and coverplate includes grooves such that the locators

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are received in the grooves, wherein the locators are provided on the coverplate and the grooves are provided in the gearhousing;

(b) the coverplate is of generally round configuration; and,

(c) the motor being a window lift motor for a vehicle.

Regarding the subsection (a) herein, Kawakami, however, teaches a motor gear structure wherein positioning projection (21n) is engaged with the corresponding positioning recess (9d), the structure element (9) and the housing (21) are positioned relative to each other.

Those skilled in the art would understand that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this instant case, it is clear to an artisan that not to provide the projection and recess positioning elements for the gear housing and the brush holder, but rather to apply the essential teaching of providing positioning projection in one of coverplate and gearhousing, and provide the corresponding positioning recess in the other of coverplate and gearhousing in order to positioning the two components relative to each other for facilitating assembling the coverplate and gearhousing together. Such practice of providing positioning projection in one of component, and providing the corresponding positioning recess in the other component for locating one relative to the other during assembling is well known in the art.

Furthermore, whether the positioning projection is provided in the coverplate, and positioning projection is provided in the gearhousing or vice versa is a matter of obvious arrangement based on the engineering design choice because either ways would not affect the function of the projection and the recess as positioning means to facilitate the assembly for the coverplate and the gearhousing.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the coverplate and the gearhousing by providing positioning means as a projection and a corresponding recess engaging one another as positioning means, taught by Kawakami. Doing so would facilitate the assembling of the coverplate and the gearhousing.

Regarding the subsection (b) herein, it would have been obvious to one skilled in the art at the time the invention was made to modify the coverplate as a generally round configuration in order to ensure proper fitting of the coverplate onto the gearhousing. Doing so would require only necessary mechanical skills in the art to determine the proper shape of the coverplate in according to the shape of the gearhousing, and such change in size or shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) (emphasis added).

Regarding the subsection (c) herein, it would have been obvious to one skilled in the art at the time the invention was made to employ a gear motor in a window lift motor for a vehicle because this is an obvious industrial application of such gear motor.

It has been held that "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *Re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-packard Co. vs Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that "Apparatus claims cover what a device is, not what it does" (emphases in original). To emphasize the point further, the court added: "An invention need not operate differently than the prior art to be patentable, but need only be different" (emphases in original).

2. **Claim 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerrand and Kawakami, as applied in the rejection against the base claim, and further in view of Isozumi et al (US 4,922,149)

The combination of Gerrand and Kawakami refs substantially discloses the claimed invention, except for the added limitations of the coverplate is molded from plastic and includes integral mounting bosses.

Isozumi, however, teaches the coverplate (4) made of resin, i.e., a type of plastic, includes integral mounting bosses (fig 4) for providing fastening means which would suppress the tensile stresses in the cover.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the coverplate includes integral mounting bosses, as taught by Isozumi. Doing so would further provide additional fastening means that would enhance the abutment of the coverplate and the gearhousing.

3. **Claims 21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerrand and in view of Isozumi.

Gerrand substantially discloses the claimed invention, except for the limitations of the following: the coverplate is molded from plastic and includes integral mounting bosses.

Isozumi, however, teaches the coverplate (4) made of resin, i.e., a type of plastic, includes integral mounting bosses (fig 4) for providing fastening means which would suppress the tensile stresses in the cover.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the coverplate includes integral mounting bosses, as taught by Isozumi. Doing so would provide fastening means for abutting the coverplate to the motor that would effectively secure the coverplate and the motor with tensile stress suppression.

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Allowable Subject Matter

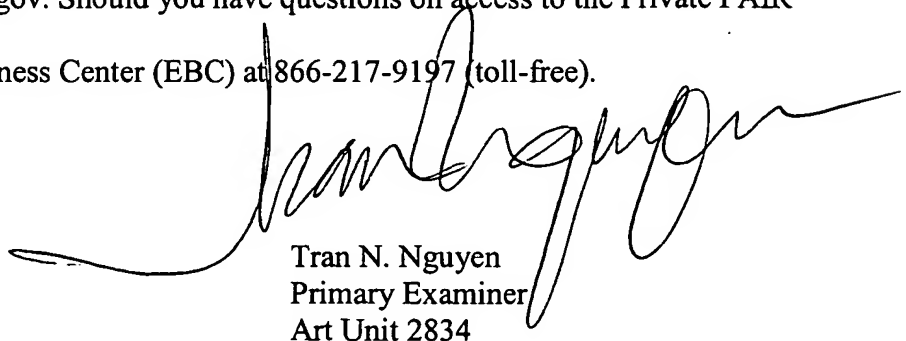
Claims 6-7, 16-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N. Nguyen whose telephone number is (571) 272-2030. The examiner can normally be reached on M-F 7:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on (571)-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tran N. Nguyen
Primary Examiner
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